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Timothy M. Farrell Intellectual Property Law Dept. IBM Corporation P.O. Box 218 Yorktown Heights, NY 10598			PLUCINSKI, JAMISUE A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

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Application Number: 09/891,163

Filing Date: June 25, 2001

Appellant(s): STIFFLER, MARK R.

GROUP 3600

Anne Vachon Dougherty
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/25/07 appealing from the Office action mailed 1/25/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 7-9, 12, 13, 16, 62, 65 and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Lederer, Jr. et al. (2002/0023109).
3. With respect to Claims 1, 4, 7-9, 12, 13, 16, 62, 65 and 68: Lederer discloses the use of a method, system and program product with instructions for operating a computer comprising the steps and means for:

- a. Storing core requirements applicable to a plurality of countries (Paragraph 0038);
- b. Storing country-specific requirements applicable to respective countries (Paragraph 0038, Lederer also discloses the use of MSDS, which give standardized shipping requirements, which the examiner considers to be core requirements);
- c. Storing on said computer country-specific summary requirements (Paragraph 0042, the examiner considers the tables to be in the form of a summary);
- d. Receiving a request for a summary report of requirements for a selected country (see abstract, and Paragraph 0038, by the order form system submitting an order to the

GRCS, for country specific requirements, that it is a request for a summary report of requirements);

e. Providing core as well as country-specific requirements (see abstract and paragraphs 0038 and 0040), it is the examiner's position that if the country specific requirements are provided, then it is inherent that the process of Lederer determines if they are there, due to the fact that how can they be provided if they weren't first determined they were there/stored.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 5, 10 and 14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lederer Jr., et al.

6. With respect to Claims 2, 5, 10 and 14: Lederer discloses the system can be used for multiple shipments, therefore there would have to be a request with a plurality of countries. Furthermore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the request by for multiple countries, since it has been held that a mere multiplicity of parts or steps involves only routine skill in the art. *St. Regis Paper Co. v Bemis Co.* 193 USPQ 8. Therefore it would have been obvious to Lederer to have the request be

for multiple carriers, do to the fact that requesting information on multiple countries, would have been at the level of ordinary skill in the art.

7. With respect to Claims 3, 6, 11, 15, 63, 64, 66 and 67: Lederer discloses providing country specific regulations as well as core regulations, however does not expressly state providing the results in a matrix format. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the results displayed in a matrix format, because Appellant has not disclosed that displaying the results in a matrix format provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Appellant's invention to perform equally well with the results disclosed in list format, because they are both provided to the user, just organized in different ways. Therefore, it would have been an obvious matter of design choice to modify Lederer to provide the results in matrix format, as specified in Claims 3, 6, 11, 15, 63, 64, 66 and 67.

(10) Response to Argument

With respect to Appellant's arguments in respect to Claims 1, 4, 7, 62, 65 and 68: The appellant asserts that the Lederer patent publication does not anticipate the invention as claimed. The appellant as stated that the present claims are directed to a method, system and program storage product which stores core requirements which are applicable to a plurality of countries as well as country-specific requirements. Appellant asserts that Lederer does not store core requirements of country specific requirements, but rather contacts a regulation source to obtain regulation information. Lederer discloses the use of storing MSDSs, which the examiner has stated contain core-requirements, which are requirements for shipping hazardous materials or any chemical

materials. Lederer also stores country-specific requirements in the GRCS, which the examiner considers to be part of the Lederer system. Therefore the examiner considers Lederer to disclose both the core-requirements as well as the country-specific requirements.

The appellant is also arguing that the present claims recite requesting requirements for one or more selected countries, and Lederer discloses the use of submitting purchase orders. First it should be noted that the type of information requested is considered to be non-functional. As written the claims merely state storing information, requesting information, retrieving information and presenting information. The type of information being stored, or retrieved is not functionally related to any of the further steps, but merely descriptive of the type of information passed between requester and the system. It is the examiner's opinion that the purchase order of Lederer functions as type of request, due to the fact that when the purchase order is sent, the information on the MSDS (core requirements) as well as the GRCS (country-specific requirements) are retrieved and presented.

The appellant is also stating the Lederer teaches that a user may request "a specific compliance-related document from the GCRS" (Paragraph 0088), but the request for a document is not the same as a request for requirements for a specific country. However the examiner considers the fact that the compliance-related document will have country-specific requirements in it, then it is essentially a request for the requirements.

The appellant is arguing that Lederer does not teach that compliance information is requested for specific countries, however when a purchase order is made, there is a origin and a destination and addresses associated there with. Therefore, it is a request for the specific countries it is shipping to and shipping from.

The arguments are not considered to be persuasive; the examiner considers Lederer to anticipate claims, 1, 4, 7, 62, 65 and 68.

With respect to arguments in regards to Claims 8, 12 and 16: The appellant is arguing that Lederer does not teach a system, method or program product including means and steps for requesting, on a computer, international shipping requirements for at least one selected country, receiving requirements applicable to a plurality of countries and an indication of respective country-specific requirements, but rather teaches the use of submitting a purchase order. As stated above, the type of information requested is considered to be non-functional. As written the claims merely state storing information, requesting information, retrieving information and presenting information. The type of information being stored, or retrieved is not functionally related to any of the further steps, but merely descriptive of the type of information passed between requester and the system. It is the examiner's opinion that the purchase order of Lederer functions as type of request, due to the fact that when the purchase order is sent, the information on the MSDS (core requirements) as well as the GRCS (country-specific requirements) are retrieved and presented.

With respect to arguments in regards to Claims 2, 5, 10 and 14: The appellant has stated that the Appellant relies on the arguments presented above with respect to claim features of claims 1 and 4, therefore as stated above, the examiner considers Lederer to disclose the features of claims 1 and 4, therefore the examiner does not consider these arguments to be persuasive. Again, the appellant is arguing that the product order is not the same as a request to receive country-specific

requirements. As stated above, the examiner considers a purchase order to be a type of request. Appellant as stated that Lederer's GRCS sends an indication of whether an ordered product can be shipped and does not provide respective country-specific requirements. However, Lederer discloses the GRCS summarizes its analysis and forwards the report to appropriate parties, therefore the examiner considers this to be a providing step.

Claims 10 and 14 recite requesting requirements for a plurality of countries and receiving respective requirements. Lederer discloses the purchase order, and the examiner equates it to the request. The purchase order has an origin and destination, therefore a plurality of locations, and Lederer discloses analyzing different regions of the purchase order in paragraph 0054. Purchase orders are commonly done with international purchases, therefore when the purchase order is for international orders, then it would be for multiple countries.

With respect to arguments in regards to Claims 3, 6, 11, 15, 63-64 and 66-67: The appellant has stated that the appellant is relying on arguments presented above with respect to the teachings of Lederer which do not anticipate features of the independent claims. As stated above by the examiner, the examiner considers the teaching of Lederer to teach the limitations of the claimed invention. The appellant is also arguing that Lederer does not teach sending the results in Matrix format. Lederer discloses providing the results, and how those results are provided, what format they are provided in, as stated by the examiner is considered to be design choice, due to the fact that the appellant has not stated the format of the results being in a matrix provides an advantage or solves a stated problem, it is merely a way of displaying something. Therefore it would be

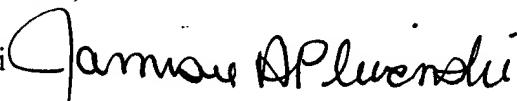
within the level of one of ordinary skill in the art to form the results in a matrix format. And Argument is not considered to be persuasive.

(11) Related Proceeding(s) Appendix

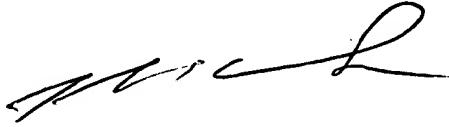
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jamisue Plucinski 

Conferees:

John Weiss 

Dean Nguyen 